

### REMARKS

Claims 24-30 and 38-45 are pending in this application and claims 31-37 have been withdrawn from consideration. Claims 24, 38 and 45 have been amended by this paper.

Claims 24-30 and 38-45 are provisionally rejected for nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent Pub. No. 2003/0025255 and claims 1-45 of U.S. Patent Pub. No. 2006/0173592. The provisional rejections are respectfully traversed.

U.S. Patent Pub. No. 2006/0173592 is a publication of the present application as of August 3, 2006. It is submitted that the claims of the present application cannot be rejected based upon a publication of the present application. Withdrawal of the provisional rejection based upon U.S. Patent Pub. No. 2006/0173592 is respectfully requested.

Furthermore, in the Office action mailed on June 22, 2006, withdrawn claims 31-37 of the present application were identified as being “independent and distinct” from pending claims 24-30 and 38-45. However, now the Office has taken the position that pending claims 24-30 and 38-45 “are not patentably distinct” from the pending claims of U.S. Patent Pub. No. 2003/0025255. To use a cliché, the Office apparently wishes to have its cake and eat it too. Therefore, withdrawal of at least one of the restriction requirement and the provisional rejection is respectfully requested.

Claims 24-30 and 38-45 are rejected for nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,754,571 to Gade et al. The ‘571 patent to Gade et al. is the patent that issued on the application published as U.S. Patent Pub. No. 2003/0025255. Therefore, for the reasons expressed above, the rejections of claims 24-30 and 38-45 are respectfully traversed.

Claims 24-30 and 38-45 are rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the enablement requirement. The rejections are respectfully traversed.

The Office has taken the position that the claims are not enabled because Fig. 3 does not disclose all the limitations of the claims. (Office action, p. 4). The Office’s argument is based upon the Applicants’ previous election of the embodiment of Fig. 3. However, the election requirement has been withdrawn (Office action, p. 2) and, accordingly, Applicants withdraw the election of the species of Fig. 3.

Furthermore, the test for enablement requires a review of the full disclosure of the patent application at the time of filing to determine whether the disclosure is sufficient to enable a person skilled in the art to practice the claimed invention without undue or unreasonable experimentation. (MPEP § 2164.01). Therefore, merely looking at Fig. 3 to determine whether pending claims 24-30 and 38-45 are properly enabled is clear error. It is submitted that pending claims 24-30 and 38-45 are fully enabled upon review of the full disclosure of the present application. Withdrawal of the rejections of claim 24-30 and 38-45 under § 112, ¶ 1 is respectfully requested.

Claims 24-30 and 38-45 are rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The rejections are respectfully traversed

The pending claims have been amended to specify that “maximum damping of the relative acceleration across the mount occurs at a predetermined band of frequencies.” It is submitted that the term “maximum” is unambiguous and well understood. Furthermore, the term “maximum” is used throughout the disclosure of the present application. (See, e.g., Application, p. 9, l. 5). Therefore, withdrawal of the rejections of claims 24-30 and 38-45 under § 112, ¶ 2 is respectfully requested.

Claims 24-30 and 38-45 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,829,319 to Mokeddem. The rejections are respectfully traversed.

The Mokeddem reference discloses an apparatus and method for controlling the torsional damping frequency of a torsional damper. In particular, the Mokeddem reference discloses a damper 10 having a disc shaped body 12 connected to a flywheel 18 and crankshaft 20. The damper 10 defines an annular chamber 30 into which inertia rings 32 are position, thereby defining a gap 36 into which MR fluid is positioned. A controller 80 controls the viscosity of the MR fluid in response to signals received from a vibration sensor 86.

In contrast, the pending claims of the present application are directed to a system and method for controlling an MR mount disposed between an object and a base. In particular, the pending claims require generating a control signal responsive to a determined relative acceleration based on at least one tunable parameter and controlling the flow of MR mount fluid in the MR mount responsive to the control signal such that maximum damping of the relative


acceleration across the mount occurs at a predetermined band of frequencies. The Mokeddem reference does not teach such a system and method. Rather, the Mokeddem reference merely teaches the use of a single vibration sensor 86 and, therefore, cannot obtain a relative acceleration.

It is axiomatic that anticipation is established only if each and every limitation of a patent claim identically appears in a single prior art reference. *See Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). Inasmuch as the Mokeddem reference fails to teach or suggest, among other things, determining a relative acceleration across an MR mount, Applicants submit that the Mokeddem reference cannot, as a matter of law, anticipate the pending claims of the present application. Therefore, withdrawal of the rejections of claims 24-30 and 38-45 under § 102(b) is respectfully requested.

Accordingly, it is submitted that the present application is in condition for allowance and formal notice thereof is respectfully requested.

The Commissioner is hereby authorized to treat any paper that is filed in this application, which requires an extension of time, as incorporating a request for such an extension. (37 C.F.R. § 1.136(a)(3)). The Commissioner is further authorized to charge any fees required by this paper or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,



Victor J. Wasylyna  
Reg. No. 52,345

THOMPSON HINE LLP  
Post Office Box 8801  
Dayton, Ohio 45401-8801  
Phone: (937) 443-6812  
E-mail: IPGroup@ThompsonHine.com

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